

ESTTA Tracking number: **ESTTA503406**

Filing date: **11/02/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

### Opposers Information

Name	MRM Holdings Limited
Granted to Date of previous extension	11/03/2012
Address	James Court, St Denis Street Suite 802 Port Louis, MAURITIUS

Name	Outpac Designs Ltd.
Granted to Date of previous extension	11/03/2012
Address	GPO Box 11464 Hong Kong, HONG KONG

Name	Outpac Designs, Inc.
Granted to Date of previous extension	11/03/2012
Address	1410 - 7th Street Plaza Suite C-1 Marysville, WA 98270 UNITED STATES

Attorney information	Michael R. Gilman Gilman Pergament LLP 1480 Route 9 North Suite 204 Woodbridge, NJ 07095 UNITED STATES mgilman@gilmanpergament.com, ilucena@gilmanpergament.com, agilman@gilmanpergament.com Phone: 732 636-4500, ext. 111
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### Applicant Information

Application No	79112841	Publication date	09/04/2012
Opposition Filing Date	11/02/2012	Opposition Period Ends	11/03/2012
International Registration No.	1063975	International Registration Date	11/25/2010
Applicant	SABE BAG ITALIA S.R.L. Via Marsala, 34/A I-21013 GALLARATE (Varese)  ITALY		

## Goods/Services Affected by Opposition


Class 018.

All goods and services in the class are opposed, namely: Leather and imitations of leather; Goods made of leather and imitations of leather, namely, luggage, attaché cases, sport bags, pouches; trunks and travelling bags


## Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Other	lack of bona fide intent to use

## Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3472293	Application Date	04/19/2006
Registration Date	07/22/2008	Foreign Priority Date	NONE
Word Mark	PACSAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Carrier bags for use on bicycles and motorcycles Class 018. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Bags, pouches, and cases for transport of personal items, namely, luggage, athletic bags, carry-all bags, duffel bags, hiking bags, kit bags, overnight bags, shoulder bags, sports bags, tote bags, travel bags, waist bags, carrying cases, briefcases, and document cases; theft-resistant and tamper-resistant bags, pouches, and cases for transport of personal items, namely, luggage, athletic bags, carry-all bags, duffel bags, hiking bags, kit bags, overnight bags, shoulder bags, sports bags, tote bags, travel bags, waist bags, carrying cases, briefcases, and document cases sold in lockable and/or reinforced form; mesh bags and nets for holding and securing luggage, athletic bags, carry-all bags, duffel bags, hiking bags, kit bags, overnight bags, shoulder bags, sports bags, tote bags, travel bags, waist bags, carrying cases, briefcases, and document cases; slash-resistant straps for luggage and handbags; all of the foregoing for use in travel		


U.S. Registration No.	3453789	Application Date	04/19/2006
Registration Date	06/24/2008	Foreign Priority Date	NONE
Word Mark	PACSAFE		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 012. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Carrier bags for use on bicycles and motorcycles</p> <p>Class 018. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Bags, pouches, and cases for storage and/or transport of personal items, namely, luggage, athletic bags, carry-all bags, duffel bags, hiking bags, kit bags, overnight bags, shoulder bags, sports bags, tote bags, travel bags, waist bags, carrying cases, briefcases, and document cases; theft-resistant and tamper-resistant bags, pouches, and cases for transport of personal items, namely, luggage, athletic bags, carry-all bags, duffel bags, hiking bags, kit bags, overnight bags, shoulder bags, sports bags, tote bags, travel bags, waist bags, carrying cases, briefcases, and document cases sold in lockable and/or reinforced form; mesh bags and nets for holding and securing luggage, athletic bags, carry-all bags, duffel bags, hiking bags, kit bags, overnight bags, shoulder bags, sports bags, tote bags, travel bags, waist bags, carrying cases, briefcases, and document cases; slash-resistant straps for luggage and handbags; all of the foregoing for use in travel</p>

U.S. Registration No.	4088017	Application Date	06/24/2011
Registration Date	01/17/2012	Foreign Priority Date	NONE
Word Mark	PACSAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2000/10/00 First Use In Commerce: 2000/10/00 Bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories; Camera cases; Carrying cases for electronic equipment, namely, computers, portable computers, laptops, notebook computers, cell and mobile phones, tablets, smart phones, digital</p>		


	cameras, electronic organizers; Carrying cases, holders and protective cases featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices; Bags, cases and backpacks for photographic and video apparatus and equipment; Plastic case used as a security device for protecting and securing DVDs and other magnetic and electronic media from theft; Protective carrying cases specially adapted for personal digital assistants (PDA); Protective covers and cases for cell phones, laptops and portable media players; Rolling cases especially adapted for holding laptops and notebook computers; Shield cases for magnetic disks; and straps for carrying cameras, video cameras, mobile phones, camera cases and mobile phone cases
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U.S. Registration No.	2347685	Application Date	06/30/1998
Registration Date	05/02/2000	Foreign Priority Date	NONE
Word Mark	PACSAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 1998/08/15 First Use In Commerce: 1998/08/15 Travel security devices, namely, mechanical metal locks, metal containers, and cloth covered metal reinforced containers for securing luggage and back packs		


U.S. Registration No.	4083643	Application Date	06/01/2011
Registration Date	01/10/2012	Foreign Priority Date	NONE
Word Mark	TRAVELSAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2004/01/29 First Use In Commerce: 2004/01/29 theft-resistant and tamper-resistant bags, pouches, and cases for transport of personal items, namely, luggage, athletic bags, carry-all bags, kit bags, overnight bags, travel bags and document cases sold in lockable and/or		

	reinforced form		
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U.S. Registration No.	4154992	Application Date	01/19/2011
Registration Date	06/05/2012	Foreign Priority Date	NONE
Word Mark	RFID SAFE		
Design Mark			
Description of Mark	The mark consists of the wording "RFID SAFE" where "SAFE" is under the letters "RFI" and a stylized propagating wave design comprised of 4 curved lines is located under the letter "D". The mark is underlined.		
Goods/Services	Class 018. First use: First Use: 2011/12/00 First Use In Commerce: 2011/12/00 Wire and polymer reinforced all-purpose carrying bags; wire and polymer reinforced travel bags; lockable reinforced all-purpose carrying bags; lockable reinforced travel bags; lockable all-purpose carrying bags; lockable travel bags; bags for travel in the nature of travel bags; all-purpose carrying bags for camping; travel bags for camping; backpacks; daypacks; across body packs, namely, sling bags that extend across or on front of a body; across body travel packs, namely, sling bags that extend across or on front of a body; waist bags; sport equipment bags in the nature of all purpose sport bags; lockable security travel bags; security pouches of textile; security wallets, purses and fanny packs; courier bags in the nature of messenger bags; document bags in the nature of backpacks and briefcases; hunting bags; all-purpose carrying bags for securing personal items; tote bags for securing personal items; duffel bags for securing personal items; weather proof luggage; bag covers and containers, namely, lockable covers to protect travel bags		


  

U.S. Registration No.	3879712	Application Date	04/12/2010
Registration Date	11/23/2010	Foreign Priority Date	NONE
Word Mark	CARRYSAFE		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2003/10/00 First Use In Commerce: 2003/10/00 Shoulder straps; Straps for carryalls; Straps for carrying cases; Straps for handbags; Straps for holdalls; Straps for luggage

U.S. Registration No.	4083638	Application Date	06/01/2011
Registration Date	01/10/2012	Foreign Priority Date	NONE

Word Mark	CARRYSAFE
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2004/01/29 First Use In Commerce: 2004/01/29 straps for cameras and camera cases


U.S. Registration No.	3287670	Application Date	11/29/2006
Registration Date	09/04/2007	Foreign Priority Date	NONE

Word Mark	PROSAFE
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 006. First use: First Use: 2004/01/31 First Use In Commerce: 2004/01/31 Metal locks, namely, padlocks, metal locks, metal padlocks, combination locks, carabiner locks, cable locks, [ metal sash locks ] and retractable cable locks; and locks for bags, luggage and backpacks

U.S. Registration No.	3880803	Application Date	05/07/2009
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Registration Date	11/23/2010	Foreign Priority Date	NONE
Word Mark	DROPSAFE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2009/10/00 First Use In Commerce: 2009/10/00 Fall arrest apparatus, namely, harnesses and nets; fall arresting apparatus for the protection of loads and fixtures, namely, harnesses and nets; fall arresting safety apparatus for the protection of workmen, namely, harnesses and nets; nets for protection against accidents; safety nets; life nets		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WalletSafe		
Goods/Services	at least wallets, but possibly also other bags of various types and sizes		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WrapSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	UltimateSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	VentureSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/Registration No.	NONE	Application Date	NONE
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Registration No.			
Registration Date	NONE		
Word Mark	MetroSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	StashSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	InfoSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	TourSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SlingSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	CitySafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	DigiSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	CoverSafe
Goods/Services	travel gear, including but not limited to, bags of various types and sizes

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PouchSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BuckleSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WristSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	StowSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	CashSafe		
Goods/Services	travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	StrapSafe		
Goods/Services	Staps for travel gear, including but not limited to, bags of various types and sizes		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	RetractaSafe
Goods/Services	travel gear, including but not limited to, cable locks

Attachments	78864353#TMSN.jpeg ( 1 page )( bytes ) 78864354#TMSN.jpeg ( 1 page )( bytes ) 85355970#TMSN.jpeg ( 1 page )( bytes ) 75510701#TMSN.gif ( 1 page )( bytes ) 85335523#TMSN.jpeg ( 1 page )( bytes ) 85220759#TMSN.jpeg ( 1 page )( bytes ) 85011401#TMSN.jpeg ( 1 page )( bytes ) 85335485#TMSN.jpeg ( 1 page )( bytes ) 77052819#TMSN.jpeg ( 1 page )( bytes ) 77731497#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition-final.pdf ( 10 pages )(154553 bytes )
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## Certificate of Service


The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Michael R. Gilman/
Name	Michael R. Gilman
Date	11/02/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>MRM HOLDINGS LIMITED, OUTPAC DESIGNS LTD, OUTPAC DESIGNS INC,</b>	X	:	
	:	:	
	:	:	
<b>Opposers,</b>	:	:	<b>Opposition No.</b>
	:	:	
<b>v.</b>	:	:	
	:	:	<b>Serial No. 79112841</b>
<b>SABE BAG ITALIA S.R.L.,</b>	:	:	
	:	:	
<b>Applicant.</b>	:	:	
	X		

**NOTICE OF OPPOSITION**


**In the matter of** Application Serial No. 79112841 (“the ‘841 application”) for registration in International Class 18 of the mark SAFE BAG and Design, , (“SAFE BAG mark”) filed March 5, 2012, and published in the Official Gazette on September 4, 2012 in the name of SABE BAG ITALIA S.R.L. (“applicant”), for “Leather and imitations of leather; Goods made of leather and imitations of leather, namely, luggage, attaché cases, sport bags, pouches; trunks and travelling bags”.

MRM HOLDINGS LIMITED, a limited liability company of Mauritius, having a place of business at St. James Court, St. Denis St., Suite 802, Port Louis, Mauritius, OUTPAC DESIGNS LTD, a limited liability company of Hong Kong, having a place of business at Flat A, 15th floor, Cheung Fat Industrial Building, 7-9 Hill Road, Western district, Hong Kong, and who is licensee of MRM HOLDINGS LTD and OUTPAC DESIGNS INC, a corporation of the state of Delaware, United States, having a place of business at of 1410 – 7th Street Plaza, Suite C-1,

Marysville, WA, 98270, UNITED STATES, who is sublicensee of OUTPAC DESIGNS LTD (herein conjointly referred to as “opposers”), believe they will be damaged by registration of the SAFE BAG mark of the ‘841 application by applicant and hereby timely oppose registration of said mark pursuant to Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. Sec. 1063, on the following grounds:

1. Opposers are respectively the owner and licensees of the following marks of the following U.S. Trademark Registrations:

A. PACSAFE, filed April 19, 2006, and issued as U.S. Trademark Registration No. 3,472,293 on July 22, 2008, covering bicycle and motorcycles carrier bags of Class 12 and numerous and various types of bags and cases, including specialty anti-theft bags and cases, of Class 18.

B. PACSAFE and Design, , filed April 19, 2006, and issued as U.S. Trademark Registration No. 3,453,789 on June 24, 2008, covering bicycle and motorcycles carrier bags of Class 12 and numerous and various types of bags and cases, including specialty anti-theft bags and cases, of Class 18.


C. PACSAFE, filed June 24, 2011, and issued as U.S. Trademark Registration No. 4,088,017 on January 17, 2012, covering numerous and various types of bags and cases for carrying different types of electronics of Class 9.

D. PACSAFE, filed June 30, 1998, and issued as U.S. Trademark Registration No. 2,347,685 on May 2, 2000, covering travel security devices, namely, mechanical metal locks, metal containers, and cloth covered metal reinforced containers for securing luggage and back packs of Class 6.

E. TRAVELSAFE, filed June 1, 2011, and issued as U.S. Trademark

Registration No. 4,083,643 on January 10, 2012, covering theft-resistant and tamper-resistant bags, pouches, and cases for transport of personal items, namely, luggage, athletic bags, carry-all bags, kit bags, overnight bags, travel bags and document cases sold in lockable and/or reinforced form of Class 18.



F. RFID SAFE and Design, , filed January 19, 2011, and issued as U.S. Trademark Registration No. 4,154,992 on June 5, 2012, covering numerous and various types of bags and cases, including specialty anti-theft bags and cases, of Class 18.

G. CAMSAFE, filed November 3, 2011, and issued as U.S. Trademark Registration No. 4,167,565 on July 3, 2012, covering numerous and various types of bags and cases for carrying different types of electronics of Class 9.

H. CARRYSAFE, filed April 12, 2010, and issued as U.S. Trademark Registration No. 3,879,712 on November 23, 2010, covering shoulder straps; straps for carryalls; straps for carrying cases; straps for handbags; straps for holdalls; straps for luggage of Class 18.

I. CARRYSAFE, filed June 1, 2011, and issued as U.S. Trademark Registration No. 4,083,638 on January 10, 2012, covering straps for cameras and camera cases of Class 9.

J. PROSAFE, filed November 29, 2006, and issued as U.S. Trademark Registration No. 3,287,670 on September 4, 2007, covering metal locks, namely, padlocks, metal locks, metal padlocks, combination locks, carabiner locks, cable locks, metal sash locks and retractable cable locks; and locks for bags, luggage and backpacks of Class 6.

K. DROPSAFE, filed May 7, 2009, and issued as U.S. Trademark Registration No. 3,880,803 on November 23, 2010, covering fall arrest apparatus, namely,

harnesses and nets; fall arresting apparatus for the protection of loads and fixtures, namely, harnesses and nets; fall arresting safety apparatus for the protection of workmen, namely, harnesses and nets; nets for protection against accidents; safety nets; life nets of Class 9.

2. Opposers are also the owner and licensees, in at least the United States, of the following additional “Safe” marks: VENTURESAFE, METROSAFE, STASHSAFE, INFOSAFE, TOURSAFE, SLINGSAFE, CITYSAFE, DIGISAFE, COVERSAFE, POUCHSAFE, WALLETSAFE, BUCKLESAFE, WRISTSAFE, STOWSAFE, CASHSAFE, STRAPSAFE, RETRACTSAFE, WRAPSAFE, ULTIMATESAFE. Various types and kinds of travel gear, including, but not limited to, bags and cases bearing these marks have been shipped in US commerce by opposers for years, with all having been used in the shipment of goods in US commerce from dates long prior to any date able to be claimed by applicant herein as a use or constructive use date for the opposed SAFE BAG mark.

3. Opposers are also respectively owner and licensees of the following marks registered in classes 6, 9 and/or 18: Australia: DROPSAFE, PACSAFE (Word & Design), RFID SAFE; Canada: PACSAFE (Word & Design); China: CAMSAFE, CARRYSAFE, CITYSAFE, COVERSAFE, DROPSAFE, PACSAFE (Word & Design), PACSAFE (Word), POUCHSAFE, RFID SAFE, SLINGSAFE, TOURSAFE; Europe: DROPSAFE, PACSAFE (Word & Design); Hong Kong: PACSAFE (Word & Design), RFID SAFE; Japan: PACSAFE (Word & Design); Korea: PACSAFE (Word & Design); New Zealand: PACSAFE (Word & Design); Philippines: PACSAFE (Word & Design); Taiwan: PACSAFE (Word & Design). All those foreign registrations show the importance of the “\_\_\_\_\_safe” family marks for the Opposers and increase the likelihood of being damaged by the registration of the SAFE BAG mark in the event of exportation of the said trademark from the US to those countries.

4. Upon information and belief, the earliest date of use applicant can claim for its SAFE BAG mark of the opposed application is the March 5, 2012 date of the Subsequent Designation of International Registration 1063975 to extend protection of said mark into the United States.

5. Opposers have rights in their family of SAFE marks for goods identical to, or closely related to, the Class 18 goods of the opposed application, which rights of opposers are all far superior by many years to any rights which may be asserted by applicant in this proceeding in its SAFE BAG mark.

6. Applicant's use of the SAFE BAG mark for all of the class 18 goods of the opposed application is highly similar to and likely to be confused with each and every individual one of opposers' family of "\_\_\_\_\_SAFE" marks, and with opposers' family of "\_\_\_\_\_SAFE" marks, as a whole, including, but not limited to, for the following reasons:

(A). Opposers' primary, standard character PACSAFE brand and applicant's SAFE BAG mark have the same sight, sound and meaning. PACSAFE and SAFE BAG are almost identical transposed marks, creating identical commercial impressions both as to their overall impressions, as well as the impressions of each mark's individual elements, so that the trademarks are similar and likely to be confused:

(1). Sight:

SAFE	Identical
PAC and BAG	Both are three letter words with the middle letter being "A", and the leading and trailing consonants being highly similar in look; i.e.,


	“P”/“B” looking highly similar and “C”/“G” looking highly similar.
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(2). Sound:

SAFE	Identical
PAC and BAG	The two sounds are highly similar as P and B, on the first hand, and C and G, on the other hand, are often orally confused.

(3). Meaning: It cannot be convincingly argued that the meanings of both marks are not identical, as a “Pac” is simply a type and/or kind of “Bag”.


(B). Opposers’  mark and applicant’s

 mark highlight even more the striking resemblance of opposers’ and applicant’s marks, including the transposed nature of these marks, since the style of writing of the marks are closely related, the “SAFE” term is emphasized in each mark (by being in bold font in opposers’ mark and by being the first term in applicant’s mark), opposers’ mark starts with the image of an animal, while applicant’s mark essentially ends with the image of an animal, and both animal images are more directly associated with the “PAC”/“BAG” elements of the respective marks.

(C). Opposers have become known in the United States not only for their primary PACSAFE brand, but also for their family of “\_\_\_\_\_SAFE” marks, all used by opposers for years to promote and sell their wide range of travel gear, including, but not limited




to, bags, cases, locks and straps, as well as security bags, cases and straps. Even in the unlikely event the Board considers that there is no likelihood of confusion between opposers' PACSAFE

standard character mark and opposers' stylized  **pacsafe** mark and applicant's stylized SAFE BAG mark, the long prior existence of opposers' family of "\_\_\_\_SAFE" marks in relation with all types and kinds of bags shall be considered as a sufficient basis to grant the present opposition as the legal precedent of both the CCPA and the Court of Appeals for the Federal Circuit hold that the family of marks doctrine provides that a likelihood of confusion can exist as to the family of marks even though a junior user's mark may not be significantly close to any one member of a senior user's family of marks.

(D). The class 18 goods of the opposed application are identical to the class 18 and 9 bags and cases sold by opposers under their family of "\_\_\_\_SAFE" marks, and are highly related to those class 6 goods also sold by opposers under their PACSAFE and PROSAFE marks.


(E). The relevant consumers of both opposers' and applicant's goods are identical.

(F). The channels of trade through which both opposers' and applicant's goods travel are, at least in some instances, identical.

7. Applicant's intention to use a mark that so closely resembles opposers' PACSAFE mark,  **pacsafe** mark and family of "\_\_\_\_SAFE" marks, all of which have constructive and/or actual use dates well prior to any date applicant may rely upon in this proceeding, evidences an intention by applicant to trade on opposers' goodwill.


8. Accordingly, there is, and would be, a likelihood of confusion, mistake and/or

deception between the class 18 goods of applicant's SAFE BAG mark of the opposed '841

application and opposers' PACSAFE mark,  mark and family of "\_\_\_\_SAFE" marks used by opposers on their identical and highly overlapping goods, to the ordinary consumer within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d).

9. Further, and upon information and belief, applicant lacked the requisite bona fide intention to use the SAFE BAG mark of the '841 application in US commerce when it filed its application to register that mark and requested extension of protection to the United States, pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141(f)(a).

10. Opposers will therefore be damaged by the registration sought by applicant, insofar as such a registration, if it were to issue, would constitute *prima facie* evidence of the validity of the registration, applicant's ownership of the SAFE BAG mark, and applicant's exclusive right to use the mark, when, in fact, applicant is not entitled to such rights by virtue of

opposers' prior rights in the PACSAFE mark,  mark and their extensive family of "\_\_\_\_SAFE" marks as asserted herein, in association with identical and highly related goods.

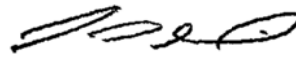
11. On the basis of the foregoing, opposers are likely to be materially harmed and damaged by issuance to registration of the class 18 goods of applicant's SAFE BAG mark of the opposed '841 application.

**WHEREFORE**, opposers pray that the instant opposition be sustained and the issuance of a registration based on Application Serial No. 79112841 to applicant be denied.

The Commissioner is authorized to charge any deficiencies in payment, or credit any overpayment, to Deposit Account No. 50-4711.

Respectfully submitted,

GILMAN PERGAMENT LLP  
Attorneys for Opposers  
1480 Route 9 North, Suite 204  
Woodbridge, NJ 07095  
Phone (732) 636-4500  
mgilman@gilmanpergament.com



Dated: November 2, 2012

By: \_\_\_\_\_  
Michael R. Gilman

**CERTIFICATE OF SERVICE**

I, Michael R. Gilman, do hereby certify that a true and correct copy of the foregoing document, entitled “**NOTICE OF OPPOSITION**,” was served on this 2<sup>nd</sup> day of November, 2012, by first class mail, postage prepaid, and by email on applicant’s attorney of record, namely:

Nicholas D. Wells, Esq.  
Wells IP Law  
299 S. Main St., Suite 1300  
Salt Lake City, UTAH 84111  
Phone Number: 801-444-7143  
Email: nwells@wellsiplaw.com

as well as on applicant itself, by International Federal Express, addressed as follows:

Sabe Bag Italia S.R.L.  
Via Marsala, 34/A  
I-21013 GALLARATE (Varese)  
ITALY

Dated: November 2, 2012

By:   
\_\_\_\_\_  
Michael R. Gilman

**CERTIFICATE OF FILING ON ESTTA SYSTEM**

I hereby certify that this document is being filed using the United States Patent and Trademark Office website ESTTA service, on this 2<sup>nd</sup> day of November, 2012.

Dated: November 2, 2012

By:   
\_\_\_\_\_  
Michael R. Gilman